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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,718	11/07/2001	Werner Bosch	FA-1038	7159

7590 04/21/2004

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EXAMINER	
FLETCHER III, WILLIAM P	
ART UNIT	**PAPER NUMBER**
1762	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/980,718	BOSCH ET AL.	
	Examiner	Art Unit	
	William P. Fletcher III	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *31-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *31-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. In the amendment filed 2/9/2004, applicant cancelled claims 1-30 (including allowed claims 21-24) and added new claims 31-35. Claims 31-35 are now pending.

Response to Arguments

2. Applicant's arguments, see the response, filed 2/9/2004, with respect to the objections set-forth in the Office action mailed 11/6/2003, have been fully considered in view of applicant's amendment and are persuasive. These objections have been withdrawn.

3. Applicant's arguments with respect to new claims 31-35 have been considered but are moot in view of the new ground(s) of rejection. The combination of Wenzel in view of Das is again cited below. Applicant preemptively argues that the motivation to combine, set-forth by the examiner in the Office action mailed 11/6/2003 (rheology improvement), is not the same as the object of applicant's invention (improved weathering resistance). In response, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Further, improved weathering resistance is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Consequently, this argument is not persuasive.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 32, 33, and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

6. The term "considerable" in claims 32 and 33 is a relative term which renders the claim indefinite. The term "considerable" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear how much water is "a considerable amount." Clearly, sufficient water must be added to adequately form a dispersion and the examiner has interpreted the claim as such.

7. Claims 32-34 recite the limitation "converting the mixture into an aqueous phase." It is unclear just what is meant by this limitation. The mixture is an aqueous dispersion comprised of an aqueous, continuous phase, and a disperse phase. Consequently, it is unclear what aqueous phase the mixture is being converted into or how such a conversion is achieved.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. **Claims 31, 32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wenzel et al. (US 4,306,998 A) in view of Das et al. (WO 97/49739 A1).**

With respect to claims 31 and 35, Wenzel '998 teaches a method of applying to a substrate a lacquer layer from a water-borne lacquer comprising an aqueous binder dispersion of a polyurethane resin into which has been incorporated about 0.3 to 50 wt.-% water-insoluble cellulose ester (abstract; 2:40-5:37; and 6:1-7:18). This reference further teaches: "The dispersions...are particularly suitable for use as coating compounds for any flexible or rigid substrate such as leather, textiles, rubber, synthetic materials such as PVC, glass, metals, paper or wood, where they may fulfill the function of a finish, lacquer or adhesive" (6:64-7:2).

Wenzel '998 does not teach applying the aqueous dispersion as a base lacquer and applying a clear lacquer layer thereto.

Das teaches aqueous cellulose ester dispersions may be used as the colored or pigmented base coat in color-plus-clear coating systems (1:8-12). In such as system, the base-coated substrate is over-coated with a transparent or clear lacquer layer (1:8-12). Cellulose ester particle dispersions eliminate coating defects through proper rheological control (1:18-25).

Since Wenzel '998 teaches that the pigmented dispersion may be used as a lacquer coating, it would have been obvious to one of ordinary skill in the art to utilize the composition of Wenzel as the pigmented base coat in a color-plus-clear coating method. One of ordinary skill

in the art would have been motivated to do so by the suggestion of Das that doing so would eliminate coating defects.

With respect to claim 32, Wenzel '998 teaches that the water-insoluble cellulose ester is mixed with the polyurethane resin in the absence of water, prior to the addition of water to form the aqueous dispersion (4:19-40).

Allowable Subject Matter

11. Claims 33 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: With respect to claims 33 and 34, while (meth)acrylated polyurethane resins are known in aqueous lacquer coating dispersions (see US 5,342,882 A), the prior art neither teaches nor suggests modifying the method of Wenzel '998 so as to (meth)acrylate the polyurethane resin thereof, either before or after the addition of water to form the dispersion.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPF 4/14/2004
William P. Fletcher III
Examiner
Art Unit 1762

SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700